Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DEREK D. CHAPMAN
and
CSABA A. KOVACS

Appeal No. 2000-1076
Application No. 09/084,904[1]

ON BRIEF

Before GARRIS, WALTZ, and KRATZ, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 5-14 which are all of the claims remaining in the application.

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[1]On page 3 of the brief, the appellants indicate that the above identified application involves patentability issues similar to those of related applications 09/027,074 (which is now also on appeal) and 09/027,078 (which is now Patent No. 6,270,943). The appellants and the examiner should consider whether the claims in these related cases (alone or in combination with prior art) would support an obviousness-type rejection of the claims before us in the subject appeal.

The subject matter on appeal relates to an optical recording element having a recording layer which comprises a metallized azo thioether dye having an azo group linking a substituted 3-hydroxypyridine nucleus to a phenyl nucleus wherein the phenyl nucleus has a thioether substituent ortho to the azo group and the phenyl nucleus is free of electron withdrawing groups. Further details concerning this appealed subject matter are set forth in representative independent claim 5 which reads as follows:

> 5. An optical recording element having a transparent substrate and on the surface of said substrate, a recording layer, a light reflecting layer; wherein the recording layer comprises a metallized azo thioether dye having an azo group linking a substituted 3-hydroxypyridine nucleus to a phenyl nucleus wherein the phenyl nucleus has an thioether substituent ortho to the azo group and is free of electron withdrawing groups on the phenyl ring and has, when unrecorded, a refractive index at a selected wavelength from 400 to 660 nm, comprising a real part (n) greater than 1.8 and an imaginary part (k) less than 0.3.

The references set forth below are relied upon by the examiner as evidence of obviousness:

Ichikawa et al. (Ichikawa)	4,906,498	Mar. 6, 1990
Takahashi et al. (Takahashi)	4,939,011	Jul. 3, 1990
Chapman et al. (Chapman)	5,500,325	Mar.

19, 1996

Bailey et al. (Bailey) EP 0 053 037 A2 Jun. 2, 1982
(published European Patent Application)

Claims 5 and 12-14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Chapman in view of Bailey; and claims 5-14 stand correspondingly rejected over these references and further in view of Takahashi and Ichikawa.

We cannot sustain either of the above-noted rejections.

Chapman discloses an optical recording element having a metallized azo dye of the type here-claimed except that patentee expressly teaches that the phenyl nucleus of his dye includes an electron withdrawing group (e.g., see the paragraph bridging columns 2 and 3 and the paragraph bridging columns 3 and 4) whereas appealed claim 1 requires that the phenyl nucleus be free of electron withdrawing groups. In this regard, Bailey discloses a photographic photosensitive silver halide element having a metallized azo dye at least similar to those disclosed by Chapman and claimed by the appellants wherein the phenyl nucleus of the dye may include various types of substituents some of which are electron withdrawing and some of which are not electron withdrawing. According to the examiner "[i]t would have been obvious to substitute for the electron withdrawing groups on the

ring, such as sulphonamido, alkylsulphonyl used in the

examples

of Chapman . . . , other groups, such as alkyl, . . . [i.e., which are not electron withdrawing] based upon their disclosed equivalence by the Bailey . . . reference" (answer, page 4).

It is well established that, when prior art references require selective combination to render obvious a subsequent invention (as here), there must be some reason for the combination other than the hindsight gleaned from the invention itself. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985). That is, something in the prior art as a whole must have suggested the desirability, and thus the obviousness, of making the combination. Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984).

In the case at bar, the Chapman and Baily references applied by the examiner would not have suggested the desirability, and thus the obviousness, of combining their teachings in such a manner as to replace the electron withdrawing groups on the phenyl nucleus of Chapman's dye with non-electron withdrawing groups as proposed by the examiner. In support of his contrary viewpoint, the examiner relies upon

Bailey as evincing that the groups in question are equivalent to one another. While these groups may be equivalent in Bailey's context of a metallized azo dye in a photographic photosensitive silver halide element, the Bailey reference certainly does not establish any such equivalency in Chapman's context of a metallized azo dye in an optical recording element.

Particularly when viewed from this last-mentioned perspective, the modification to Chapman proposed by the examiner (and needed in order to achieve the here-claimed invention) is not supported by the applied reference evidence. Stated otherwise, the applied references contain nothing to support the conclusion that an artisan would have found it desirable to replace the electron withdrawing group in the metallized azo dye of Chapman's optical recording element with a group which is not electron withdrawing in accordance with Bailey's teachings. The evidentiary absence of such desirability is particularly egregious in this instance due to the fact that this modification of Chapman is directly contrary to patentee's express teaching that his dye contains an electron withdrawing group.

In summary, the Chapman and Bailey references fail to establish a prima facie case of obviousness with respect to the optical recording element defined by the appealed claims. For this reason and because the Takahashi and Ichikawa references

have not been relied upon by the examiner for supplying the above discussed deficiencies of Chapman and Bailey, we cannot sustain either of the Section 103 rejections advanced on this appeal.

The decision of the examiner is reversed.

REVERSED

BRADLEY R. GARRIS Administrative Patent Judge	)	
THOMAS A. WALTZ Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
PETER F. KRATZ Administrative Patent Judge	)	

BRG:hh

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